

MR3003-49

Serial Number: 10/617,722

Reply to Office Action dated 31 May 2005

**REMARKS/ARGUMENT**

This case has been carefully reviewed and analyzed in view of the Official Action dated 31 May 2005. Responsive to the rejections made in the Official Action, Claim 14 has been amended to clarify the language thereof and the combination of elements which form the invention of the subject Patent Application. Additionally, Claims 1 - 13 and 15 - 17 have been cancelled by this Amendment.

In the Official Action, the Examiner rejected Claims 14 - 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Additionally, the Examiner rejected Claims 14 - 20 under 35 U.S.C. § 101, because the claimed invention was not supported by either a substantial asserted utility or a well-established utility. Both of the aforesaid rejections were based on the same deficiency in the claims, that of the recitation of "when said connection port is not used ...", which the Examiner stated does not occur, and thus, those method steps which would occur under that condition are never realized.

Applicant's reference to the connection port not being used refers to the connection port not being used by the host controller, which use would prohibit the controlling apparatus from switching to the device function mode. Thus, the claims have been amended to specifically define the condition as when said

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connection port is not being used by said host controller, which condition does occur and thus the device and the method therefore has utility. Further, such amendment clarifies the language of the claim such that the claims now particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

In the Official Action, the Examiner rejected Claims 1 - 11 under 35 U.S.C. § 102(e), as being anticipated by Matsuda et al., U.S. Patent No. 2003/0023804. The Examiner also rejected Claims 12 - 16 under 35 U.S.C., § 103(a), as being unpatentable over Matsuda.

Claim 14, as now amended, has the subject matter of Claims 15 - 17 added thereto, which includes the steps of providing a predetermined waiting time; determining whether a connection is established for the USB controlling apparatus; when said connection is established, said USB controlling apparatus is operated in said device function mode; and, when said connection is not established, examining whether said connection is established within said predetermined waiting time. Those method steps are neither disclosed nor suggested by Matsuda et al. Nowhere does the Matsuda et al. reference disclose or suggest the establishment of a time period in which a connection must be established when in the device function mode.

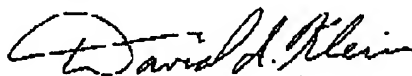
Therefore, as the Matsuda et al. reference fails to disclose each and every one of the method steps of the invention of the subject Patent Application, it

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cannot anticipate that invention. Further, as the reference fails to suggest such a combination of method steps, it cannot make obvious that invention either.

For all the foregoing reasons, it is now believed that the subject Patent Application has been placed in condition for allowance, and such action is respectfully requested.

Respectfully submitted,  
FOR: ROSENBERG, KLEIN & LEE



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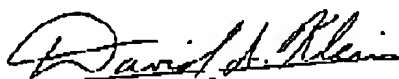
Dated: 31 Aug 2005

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FOR: ROSENBERG, KLEIN & LEE

  
DAVID I. KLEIN

8/31/2005  
Date